

Notice of Allowability

Application No.

09/938,641

Examiner

Kathleen M Kerr

Applicant(s)

MARX ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/29/04.
2. ☒ The allowed claim(s) is/are 1,3-6,10-12,19-22,26,29,40-43 and 50-53.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


Kathleen M Kerr
Primary Examiner
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DETAILED ACTION

Application Status

1. In response to the previous Office action, a non-final rejection (mailed on September 16, 2004), Applicants filed a response and amendment received on November 29, 2004. Said amendment cancelled Claims 13-15, 17, 27, 28, and 39, amended Claims 1, 6, 10-12, 16, 22, and 26, and added new Claims 40-53. Thus, Claims 1, 3-6, 10-12, 16, 19-22, 26, 29, and 40-53 are pending in the instant Office action.

Election/Rejoinder

2. New Claims 44-48 and 50-53 are drawn to the elected invention. New Claims 40-43 and 49 belong in Group IV (original claims 31-37) of the restriction requirement of record (see paper mailed June 10, 2003).

3. Claim 1 is directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), original claims 31-37, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. The subject matter of said claims had been cancelled by Applicant during prosecution and is now the subject matter of new claims 40-43 and 49. Thus, process claims 40-43 and 49 hereby rejoined and fully examined for patentability under 37 C.F.R. § 1.104; the previous restriction requirement between Claim 1 and Claim 31 is herein **WITHDRAWN**.

In accordance with the Official Gazette notice, *supra*, process original claims 7-8 and 24-25, which do not depend from or otherwise include all the limitations of the allowable product, are NOT been rejoined. Original claims 7-8 and 24-25 are drawn to methods of detecting sequence related to SEQ ID NO:1 using *parts* of said sequence; this is not commensurate with the scope of allowed Claim 1.

Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), original claims 9 and 23 directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined and the restriction of these claims is **herein WITHDRAWN**. Note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. § 804.01. Claims 9 and 23 have been previously cancelled by Applicant and thus are not subject to rejoinder herein.

4. Claims 1, 3-6, 10-12, 16, 19-22, 26, 29, and 40-53 are pending in the instant Office action and will be examined herein.

Priority

5. As previously noted, the instant application is granted the benefit of U.S. Provisional Application 60/279,415 filed on March 29, 2001 and foreign applications 10042052.4 and 10110053.1 filed in Germany on August 26, 2000 and March 2, 2001, respectively.

Certified translations of the foreign applications have been received.

Withdrawn - Claim Rejections - 35 U.S.C. § 112

6. Previous rejection of Claims 13-15, 17, 27, 28, and 39 under 35 U.S.C. § 112, first paragraph, scope of enablement, is withdrawn by virtue of Applicant's cancellation of said claims.

Withdrawn - Claim Rejections - 35 U.S.C. § 102

7. Previous rejection of Claims 15 and 16 under 35 U.S.C. § 102(e) as being anticipated by Nakagawa *et al.* (USPAP 20020197605) is withdrawn by virtue of Applicant's cancellation of said claim and/or the Examiner's amendment below.

EXAMINER'S AMENDMENT

8. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Thomas Cunningham on February 15, 2005.

Amendments to the Claims

9. The claims have been amended as follows:
- a) Cancel Claims 16 and 44-49.

b) Rewrite Claim 6 as follows:

---6. The host cell of Claim 4, wherein said host cell is selected from the group consisting of *Corynebacterium glutamicum*, *Corynebacterium acetoglutamicum*, *Corynebacterium acetoacidophilum*, *Corynebacterium melassecola*, *Corynebacterium thermoaminogenes*, and *Brevibacterium flavum*.---

c) Rewrite Claim 22 as follows:

---22. The host cell of Claim 20, wherein said host cell is selected from the group consisting of *Corynebacterium glutamicum*, *Corynebacterium acetoglutamicum*, *Corynebacterium acetoacidophilum*, *Corynebacterium melassecola*, *Corynebacterium thermoaminogenes*, and *Brevibacterium flavum*.---

d) Rewrite Claim 40 as follows:

---40. A method for making an L-amino acid comprising:

culturing in a suitable medium a cell comprising a polynucleotide encoding SEQ ID

NO:2, and

recovering the L-amino acid,

wherein said cell overexpresses said polynucleotide and wherein said overexpression is achieved by increasing the copy number of said polynucleotide or operably linking to said polynucleotide a promoter or expression cassette to increase the expression of said polynucleotide.---

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e) Rewrite Claim 43 as follows:

---43. The method of Claim 40, wherein said cell is selected from the group consisting of *Corynebacterium glutamicum*, *Corynebacterium acetoglutamicum*, *Corynebacterium acetoacidophilum*, *Corynebacterium melassecola*, *Corynebacterium thermoaminogenes*, and *Brevibacterium flavum*.---

f) Rewrite Claim 52 as follows:

---52. A *Corynebacterium* modified to contain a polynucleotide encoding SEQ ID NO:2 under the control of an exogenous promoter or expression cassette, wherein the expression of the gene product of said polynucleotide is increased relative to a corresponding, unmodified *Corynebacterium*.---

Conclusion

10. Claims 1, 3-6, 10-12, 19-22, 26, 29, 40-43, and 50-53 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr
Primary Examiner
Art Unit 1652

February 15, 2005